



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Seiichi NISHIKAWA

Group Art Unit: 2876

Application No.: 10/520,921

Examiner: R. KELLY

Filed: January 12, 2005

Docket No.: 123744

For: SIM, SIM HOLDER, IC MODULE, IC CARD AND IC CARD HOLDER

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the June 9, 2008 Restriction Requirement, the statutory period for reply being extended by the attached Petition For Extension of Time, Applicant provisionally elects Group 1, claims 1-8, 16, 17, 35-43 and 54-58, which are drawn to a SIM, an IC module, or an IC card having contact interface, a non-contact interface and a USB interface, with traverse.

National stage applications filed under 35 U.S.C. §371 are subject to unity of invention practice as set forth in PCT Rule 13, and are not subject to U.S. restriction practice. *See* MPEP §1893.03(d). PCT Rule 13.1 provides that an "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." PCT Rule 13.2 states:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

A lack of unity of invention may be apparent “*a priori*,” that is, before considering the claims in relation to any prior art, or may only become apparent “*a posteriori*,” that is, after taking the prior art into consideration. See MPEP §1850(II), quoting *International Search and Preliminary Examination Guidelines* (“ISPE”) 10.03. Lack of *a priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If *a priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. *Id.*

Furthermore, unity of invention only needs to be determined in the first place between independent claims, and not the dependent claims, as stated in ISPE 10.06:

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By “dependent” claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (Rule 6.4).

See also MPEP §1850(II). ISPE 10.07 further provides:

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

See also MPEP §1850(II).

Independent claims 1, 6, 7, 18, 28, 35, 44, 54, 56, 57 and 65 of Groups 1-4 share common subject matter, e.g., each of these claims at least relate to a SIM, an IC module, an IC card and a SIM holder that detachably holds a SIM. Furthermore, the Restriction Requirement improperly restricts the dependent claims. For example, dependent claims 9-15 and 59-64 of Group 2 depend from independent claims 6 and 57, which are of Group 1.

Accordingly, all the claims share common subject matter and, therefore, *a priori* unity of invention exists between all the claims. Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claim are known. *See* ISPE 10.07 and 10.08.

The Office Action does not establish that each and every element of the subject matter that is common to independent claims 1, 6, 7, 18, 28, 35, 44, 54, 56, 57 and 65, is known in the prior art. Therefore, Applicant respectfully submits that lack of unity of invention has not been established, and thus a restriction requirement based on a lack of unity of invention is improper.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

Respectfully submitted,



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Attachment:
Petition For Extension of Time

Date: September 5, 2008

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